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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,913	11/21/2003	Gary A. Dahl	EPICEN-09580	3340
72960	7590	02/17/2009		
Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711				
EXAMINER				
STAPLES, MARK				
ART UNIT		PAPER NUMBER		
1637				
MAIL DATE		DELIVERY MODE		
02/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,913

Applicant(s)

DAHL ET AL.

Examiner

MARK STAPLES

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-40 is/are pending in the application.
- 4a) Of the above claim(s) 8, 9, 11-15, 31-35, and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 16-30, 36-38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment of claims 7, 26, 30, and 36 in the paper filed on 11/19/2008 is acknowledged.

Claims 7, 10, 16-30, 36-38, and 40 are pending and at issue.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Rejections that are Maintained

Claim Rejections Maintained - 35 USC § 103

2. The rejection of claims 7, 10, 16-24, 26, 28, 30, 36, 38, and 40 under 35 U.S.C. 103(a) as being unpatentable over Soares et al. (United States Patent 5,830,662 issued November 3, 1998) and Lorincz et al. (US Patent No. 6,136,535, issued Feb. 2000, previously cited) is maintained. Applicant's arguments have been fully considered but they are not persuasive.

Applicant asserts that Lorincz does not teach the amended claim step of:

“(3) annealing an anti-sense promoter oligonucleotide to the sense promoter containing first- strand cDNA to obtain a transcription substrate” (instant claim 7)

However, Lorincz specifically teaches (see column 5 lines 40-54):

"Continuous Amplification Reaction ("CAR") is capable of amplifying a nucleic acid template in order to produce a detectable amount of RNA product. The amplification method can detect as little as 10-100 molecules of nucleic acid. The method uses an oligonucleotide comprising at least one segment complementary to one strand of a target sequence and a segment containing a promoter" and thus teaches the promoter oligonucleotides. Lorincz further teaches:

"This oligonucleotide primer, when hybridized [by annealing] to a strand of a template, preferably the anti-sense strand [but can also be the sense strand], and extended can generate a copy of the target nucleic acid with the capability of transcription via the added promoter sequence" and thus teaches annealing an anti-sense promoter oligonucleotide to the sense promoter to obtain a transcription substrate. This also shown in Figure 1A as presented in the prior Office action and which teaching Applicant does not rebut.

Applicant also apparently asserts that Lorincz does not teach the amended claim limitation by actual labeling in Figure 4. But there is no need to rely on Figure 4 by itself as these teaching are found in Figure 1A. And regardless, Lorincz teaches that Figure 4 is another embodiment of CAR including the primer-promoter oligonucleotide, and that target nucleic acid is a single stranded target DNA (see column 7 line 11-19) which further reads on the instant claims. And although not argued, it is noted that both Soares et al. and Lorincz et al. teach cDNA as given in the prior Office Action.

Thus the rejection is maintained.

3. The rejection of claims 25, 27, 29, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soares et al. and Lorincz et al. as applied to claims 26 and 36 above, and further in view of Hall et al. (US Patent No. 5,994,069, issued 1999, previously cited) is maintained. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that as the rejection over Soares et al. and Lorincz et al. should be withdrawn that this rejection further in view of Hall et al. should also be withdrawn. However, the rejection over Soares et al. and Lorincz et al. is maintained and thus this rejection is maintained.

Conclusion

4. No claim is free of the prior art.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Staples whose telephone number is (571) 272-9053. The examiner can normally be reached on Monday through Thursday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Staples
/M. S./
Examiner, Art Unit 1637
February 11, 2009

/Kenneth R Horlick/
Primary Examiner, Art Unit 1637